

### REMARKS

Applicants have amended claim 6 and added new claims 11-13 to more particularly point out and distinctly claim the subject matter which they regard as their own invention. Support for amended claim 6 can be found in the specification, page 12, lines 17-24; page 13, lines 5-9; page 21, lines 15-21; and page 21, line 26 through page 22, line 12. Support for the new claims can also be found in the specification. More specifically, support for new claim 11 appears at page 5, lines 28-30 and support for new claims 12 and 13 appear at page 24, lines 28-30. Applicants have also amended claims 7-9 to rectify minor deficiencies. Claims 1-5 have been cancelled. In addition, Applicants have corrected a typographical error in the specification. No new matter has been introduced by the above amendments.

Upon entry of the above amendments, claims 6-13 will be pending and under examination. Reconsideration of this application, as amended, is respectfully requested in view of the following remarks.

### Objections

The Examiner objects to the specification, pointing out a typographical error. Specifically, he asserts that "methylene" at page 9, line 7 should be "ethylene." See the Office Action, page 2, lines 5-8. Applicants have corrected the error.

The Examiner objects to claims 4 and 9 asserting that the language recited in these claims is confusing. Claim 4 has been cancelled. Applicants have amended claim 9 to eliminate the confusion.

### Rejections under 35 U.S.C. 102

The Examiner rejects claims 1-10 for anticipation under various grounds. More specifically, he rejects (1) claims 1, 2, 4-7, 9, and 10, relying on Tonge, U.S. Patent No. 4,764,554 (Tonge); (2) claims 1-5, relying on JP 2001240630 (JP '630); (3) claims 1-10, relying on JP 2002013096 (JP '096); (4) claims 1, 2, 6, and 7, relying on Kuropka, U.S. Patent No. 5,705,553 (Kuropka); and (5) claims 1 and 2, relying on Kernstock, U.S. Patent No. 4,552,685.

As claims 1-5 have been cancelled, Applicants will only traverse below the Examiner's rejections of claims 6-10. Claim 6, the only independent claim, is discussed first.

Claim 6, as amended, covers a composition for vibration damper. The composition features a solid content of 60-85% by mass.

Claim 6 is rejected as being anticipated by Tonge, JP '096, and Kuropka.

Tonge describes a polymer-containing thickener. It includes a working example of preparing an emulsion paint containing such a thickener. In addition to the thickener, the emulsion paint also contains an inorganic filler and a vinyl acetate copolymer emulsion (corresponding to the copolymer latex recited in claim 6). Tonge does not specify the solid content in the emulsion paint. According to the three tables shown in column 4, the total amount of all ingredients in the emulsion paint is 9158 parts.<sup>1</sup> Among all, the major solid ingredients are 300 parts by weight China clay, 495 parts by weight calcium carbonate, and 2250 parts by weight titanium dioxide pigment. In other words, the total amount of the major solid ingredients are 3045 parts. As such, Tonge's composition has a solid content of about 33% ( $3045/9158 \times 100\%$ ) by mass, which is much lower than the solid content of 60-85 % by mass in the composition of claim 6. Thus, claim 6 is not anticipated by Tonge.

Applicants now turn to JP '096 and Kuropka. JP '096 teaches a polymer thickener. It also teaches a paper coating composition containing such a polymer thickener, a latex binder, and pigments such as clay, calcium carbonate, and zinc oxide (which correspond to the inorganic filler recited in claim 6). However, this reference does not disclose that the paper coating composition contains a solid portion of 60-85% by mass. Neither does Kuropka. Rather, Kuropka teaches a composition having a solid content of 10 to 50% by mass, preferably 20-40% by mass, which is much higher the solid content of 60-85% recited in claim 6. See column 5, lines 32-34.<sup>2</sup> As neither JP '096 nor Kuropka teaches a composition having a solid content of

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<sup>1</sup> The total amount is the sum of the number listed in the three tables, i.e., 2162 parts + 6 parts + 100 parts + 52 parts + 100.5 parts + 67.5 parts + 30 parts + 300 parts + 495 parts + 300 parts + 2250 parts + 510 parts + 1830 parts + 300 parts + 627 parts + 40 parts = 9158 parts.

<sup>2</sup> Kuropka includes 12 examples. Each of the exemplary compositions had a solid content of 30.5-31.0% by weight. See Table 1.

60-85% by mass as required by claim 6, claim 6 is clearly not anticipated by these two references.

For the same reasons set forth above, claims 7-10, dependent from claim 6, are also not anticipated by Tonge, JP'096, or Kuropka.

Applicants would like to point out that claim 6 can be distinguished from Tonge on a second and independent ground.

The composition of claim 6 includes, per 100 parts the solid portion, (1) 0.01-2 parts by mass a thickener containing a polymer having an alkali-soluble monomer unit and an associating monomer unit, (2) 10-60 parts by mass a water-based copolymer latex, and (3) 40-90 parts by mass an inorganic filler. In other words, the thickener is at most 2% by mass of the solid portion of the composition.

As mentioned above, Tonge describes a working example of preparing an emulsion paint containing a thickener, an inorganic filler and a vinyl acetate copolymer emulsion (corresponding to the copolymer latex recited in claim 6). According to the three tables shown in column 4, the emulsion paint contains a total of 3287 parts by weight water,<sup>3</sup> a total of 400 parts by weight a thickener,<sup>4</sup> and a total of 5471 parts by weight other ingredients.<sup>5</sup> Assuming all the other ingredients are solid, the thickener is 7.31% ( $400/5471 \times 100\%$ ) of the solid portion of the emulsion paint. If any of the other ingredients is not solid, the percentage of the thickener relative to the solid portion is higher than 7.31%. In other words, Tonge's emulsion paint contains a thickener at least 7.31% of the solid portion. By contrast, the composition of claim 6 contains a thickener at most 2% of the solid portion. Thus, claim 6 is not anticipated by Tonge.

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<sup>3</sup> The total amount of water is the sum of 2160 parts listed in the first table and 510 parts and 617 parts listed in the third table. The sum is 3287 parts.

<sup>4</sup> The total amount of a thickener is the sum 100 parts listed in the first table and 300 parts listed in the second table. The sum is 400 parts.

<sup>5</sup> The total amount of other ingredients is the sum of the number listed in the three tables except those for water or a thickener, i.e., 6 parts+52 parts+100.5 parts+67.5 parts+30 parts+300 parts+495 parts+300 parts+2250 parts+1830 parts+40 parts. The sum is 5471 parts.

Rejections under 35 U.S.C. 103

The Examiner rejects claims 6-10 for obviousness over JP '630 in view of Nkansah et al., U.S. Patent No. 5,814,374 (Nkansah). Claim 6, from which claims 7-10 depend, is discussed first.

As mentioned above, claim 6 covers a composition for vibration damper. Its patentability resides at least in part in the unique amounts of the recited ingredients relative to the solid portion of the claimed composition, i.e., 0.01-2 parts by mass a thickener, 10-60 parts by mass a water-based copolymer latex, and 40-90 parts by mass an inorganic filler. The patentability also resides in the recited solid content, i.e., 60-85% by mass.

JP '630 discloses an alkali-soluble copolymer having high viscosity, which can be used as a thickener. Of note, this reference does not disclose or even suggest a filler and a copolymer latex at all. It therefore clearly does not render obvious claim 6, drawn to a composition containing a filler and a copolymer latex in addition to a thickener. It of course also does not disclose or suggest the unique relative amounts of the three gradients and the solid content recited in claim 6. Nkansah does not cure the deficiency of JP '630. It indeed discloses an aqueous coating composition containing a latex polymer binder and a filler. Yet, nowhere in this reference is taught or suggested that the unique relative amounts and the solid content recited in claim 6.

In sum, neither JP '630 nor Nkansah teaches or suggests a composition having a solid content of 60-85% by mass and containing 0.01-2 parts by mass a thickener, 10-60 parts by mass a water-based copolymer latex, and 40-90 parts by mass an inorganic filler as required by claim 6. A combination of these two references also fails to do so. Thus, JP '630 and Nkansah, either alone or taken together, does not render claim 6 obvious.

For the same reasons set forth above, claims 7-10 are also not rendered obvious by JP '630 and Nkansah.

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New claims 11-13

Claims 11-13 depend from claim 6. As claim 6 is novel and unobvious over the cited references, so are claims 11-13.

CONCLUSION

Applicants submit that the rejections asserted in the Office Action have been overcome and claims 6-13, as pending, are novel and unobvious over the cited prior art. Applicants respectfully request that all pending claims be allowed.

Enclosed is a \$1020 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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